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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

_____

Ex parte RANDY L. PRAKKEN,
JOHN CORRIGAN,
and GLENN F. WIDENER

_____

Appeal 2009-013086
Application 09/754,927
Technology Center 3600

_____

Before MURRIEL E. CRAWFORD, HUBERT C. LORIN, and
ANTON W. FETTING, *Administrative Patent Judges.*

LORIN, *Administrative Patent Judge.*

DECISION ON APPEAL[1]

_____

[1] The two-month time period for filing an appeal or commencing a civil
action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing,
as recited in 37 C.F.R. § 41.52, begins to run from the "MAIL DATE"
(paper delivery mode) or the "NOTIFICATION DATE" (electronic delivery
mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

Randy L. Prakken et al. (Appellants) seek our review under 35 U.S.C. § 134 (2010) of the final rejection of claims 1-26. We have jurisdiction under 35 U.S.C. § 6(b) (2010).

SUMMARY OF DECISION

We REVERSE.[2]

THE INVENTION

This invention is a "document distribution system for transmitting a data file from one computer to another." Specification [0002].

Claim 1, reproduced below, is illustrative of the subject matter on appeal.

> 1. For a data file distribution and processing system including server software running on a source computer for sending data files to a destination computer via a network link between the source computer and the destination computer, and including processing software running on the destination computer for processing each data file forwarded thereto from said server software to carry out an action, a method for preventing the processing software running on the destination computer from processing data files forwarded to the destination computer other than from the server software, the method comprising the steps of:

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[2] Our decision will make reference to the Appellants' Appeal Brief ("Br.," filed Oct. 19, 2008), the Examiner's Answer ("Answer," mailed Jan. 23, 2009), and the Final Rejection ("Final Rejection," mailed Jan. 9, 2008).

> including within the server software running
> on the source computer license stamping means for
> embedding a license stamp into each data file
> before the server software forwards the data file to
> said destination computer via said network link;
> and
>
> adapting said processing software executed
> by said destination computer so that it processes
> each received data file to carry out said action only
> when the received data file contains the embedded
> license stamp, wherein the license stamp
> embedded in the data file indicates that the data
> file was forwarded by licensed server software.

THE REJECTIONS

The Examiner relies upon the following as evidence of
unpatentability:

Stefik   US 5,629,980   May 13, 1997

The following rejection is before us for review:

   1. Claims 1-26 are rejected under 35 U.S.C. §103(a) as being
      unpatentable over Stefik.

ISSUE

The issue is whether claims 1-26 are unpatentable under 35 U.S.C.
§103(a) over Stefik.

FINDINGS OF FACT

We find that the following enumerated findings of fact (FF) are
supported by at least a preponderance of the evidence. *Ethicon, Inc. v.*

Quigg, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

1. Stefik describes a set of descriptor blocks (d-blocks) being attached to a digital work. *See* col. 9, l. l8- col. 10, l. 7.

2. Stefik describes a d-block as including unique identifier for a repository and usage rights. Col. 9, ll. 52-63. *See also* col. 11, ll. 33 – col. 12, ll. 30 and Fig. 7.

3. Stefik describe that Repository I checks the usage rights of a digital work to determine if access may be granted to Repository II, a requesting repository. Col. 7, ll. 21-33. *See also* col. 31, l. 5-col. 32, l. 26 (". . .the server checks. . .").

4. Stefik describes the repository's own software as having a digital certificate and states: "If the digital certificate cannot be found in the digital work or the master repository which generated the certificate is not known to the repository receiving the software, then the software cannot be installed." Col. 13, l. 24-41.

5. Stefik describe the repositories as having a plurality of identification certificates 1306 which are coupled to the core repository services. Col. 15, ll. 4-7.

6. Stefik discloses that the identification certificates are transferred between repositories in a registration message during a session initiation transaction. Col. 27, l. 30-col. 28, l. 31.

PRINCIPLES OF LAW

Obviousness

> Section 103 forbids issuance of a patent
> when 'the differences between the subject matter
> sought to be patented and the prior art are such that
> the subject matter as a whole would have been
> obvious at the time the invention was made to a
> person having ordinary skill in the art to which
> said subject matter pertains.

KSR Int'l Co. v. Teleflex Inc., 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, and (3) the level of skill in the art. *Graham v. John Deere Co*., 383 U.S. 1, 17-18 (1966). *See also KSR*, 550 U.S. at 407 ("While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.") The Court in *Graham* further noted that evidence of secondary considerations "might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented." *Graham,* 383 U.S. at 17-18.

ANALYSIS

The rejection of claims 1-26 under §103(a) as being unpatentable over Stefik.

Claims 1-11

The Appellants and the Examiner dispute whether Stefik teaches adapting said processing software executed by said destination computer so that it processes each received data file to carry out said action *only when the*

received data file contains the embedded license stamp. Br. 11-12 and Answer 3-4 and 8-9. In the Answer the Examiner seems to put forth two different rationales for rejecting claim 1. *See* Answer 3-4 and 8-9.

In the rejection in the Answer, the Examiner seems to rely upon Stefik's d-blocks, which include a unique number that identifies the repository, as the claimed license stamp, and then relies upon Stefik's disclosure of requiring a repository's software to be digitally certified before the repository's software can be installed as teaching the claimed adapting step. *See* Answer 3-4. *See also* Final Rejection 2-3. The Examiner cites column 9, lines 52-53; column 15, lines 6-7; column 13, lines 37-40; and column 42-lines 55-60 to teach the steps recited in claim 1. The Examiner then concludes:

> Note the "unique number", above, identifies the repository from which the digital item has come. Thus, the destination computer is responding to the license stamp, and "the master repository which generated the certificate is not known to the repository receiving the software, then the software cannot be installed." (col 13, ln 37-40). Note that the "unique number", above, identifies the repository from which the digital item has come. Thus, the destination computer is responding to the license stamp, by preventing software on the computer from carrying out an action, such as installation relative to the data file.

Answer 4.

However, the Examiner's conclusion that the destination computer is responding to the license stamp is not supported by Stefik. Stefik does not describe that repository II (i.e., the destination computer) is adapted to respond to the d-block information (i.e., the license stamp), and Stefik does

not disclose that the "digital certificate" described in column 13, lines 30-41 or the "identification certificate" described in column 15, lines 6-7 are part of a license stamp that was encoded in a digital work by a license stamping means on a source computer. While Stefik does describe attaching the d-blocks (i.e., the license stamps) to the digital works (FF 1-2), Stefik does not disclose that the d-blocks are used by repository II (i.e., the destination computer). Stefik instead discloses that repository I (i.e., the source computer) using the information in the d-block to allow or block transfer of the digital work. FF 3. Further, while Stefik does describe that a receiving repository will not install software if a "digital certificate" can not be found in column 13, lines 27-31 (FF 4), Stefik is silent as to whether or not digital certificate is encoded into the software by a license stamping means of the source computer. Finally, while Stefik does describe "identification certificates" in column 15, lines 6-7 (FF 5), Stefik does not disclose that the identification certificates are encoded in a digital work. Instead Stefik discloses that the identification certificates 1306 are coupled to the core repository services and are transferred between repositories in a registration message during a session initiation. FF 5-6. We fail to see how these teaching in Stefik, supports the Examiner's conclusion that "the destination computer is responding to the license stamp, by preventing software on the computer from carrying out an action, such as installation relative to the data file." Answer 4.

Further, we note that in responding to the Appellants' arguments, the Examiner's rationale with regards to claim 1 relies upon characterizing the compatibility checking script described in column 42, lines 55-60 of Stefik as an "option code." Answer 8-9. *See also* Answer 4-5. The Specification

describes "option codes" as part of the license stamp. Specification [0025] and [0026]. The Examiner then concludes: "It would be obvious to one of ordinary skill in the art to adapt Stefik to include different options in the option codes, motivated by the needs of the consumers and providers. These option codes, *inter alia*, prevent actions on a file after the file has been received." Answer 9. However, "[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *KSR Int'l Co. v. Teleflex*, 550 U.S. 398, 418 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). The Examiner provides no reasoning with rational underpinning to support their conclusions, including that the compatibility checking script is equivalent to the claimed license stamp or that the compatibility checking script is encoded into a data file as claimed

Accordingly, we find that the Examiner has failed to establish a prima facie showing of obviousness. The Appellants have overcome the rejection of claims 1 and claims 2-11, dependent thereon, under 35 U.S.C. § 103(a) over Stefik.

Claims 12-22

Similar to claim 1, claim 12 requires a destination computer that has a structure that is capable of "processing [the] received data file to carry out [the] action only when the received data file contains the embedded license stamp." The Examiner relies upon the same rationale used to reject claim 1 to reject claim 12. Answer 3. For the same reasons as discussed above with regards to claim 1, we find that the Examiner has failed to establish a prima

facie showing of obviousness in rejecting claim 12. The Appellants have

overcome the rejection of claims 12 and claims 11-22, dependent thereon,

under 35 U.S.C. § 103(a) over Stefik.

Claims 23-26

Claim 23 recites: "second means for receiving the data file, for

checking the data file to determine whether the data file contains an encoded

license, an for thereafter processing the data file only when the data file

contains the encoded license." This limitation is written in means-plus-

function format.

35 U.S.C. § 112, paragraph 6:

> An element in a claim for a combination may be
> expressed as a means or step for performing a specified
> function without the recital of structure, material, or acts
> in support thereof, and such claim shall be construed to
> cover the corresponding structure, material, or acts
> described in the specification and equivalents thereof.

Construing means-plus-function claim language in accordance with 35

U.S.C. § 112, paragraph 6, is a two step process.

> The first step in construing a means-plus-function claim
> limitation is to define the particular function of the claim
> limitation. *Budde v. Harley-Davidson, Inc.*, 250 F.3d
> 1369, 1376 (Fed.Cir.2001). "The court must construe the
> function of a means-plus-function limitation to include
> the limitations contained in the claim language, and only
> those limitations." *Cardiac Pacemakers, Inc. v. St. Jude
> Med., Inc.*, 296 F.3d 1106, 1113 (Fed.Cir.2002). . . . The
> next step in construing a means-plus-function claim
> limitation is to look to the specification and identify the
> corresponding structure for that function. "Under this
> second step, 'structure disclosed in the specification is
> "corresponding" structure only if the specification or

9

> prosecution history clearly links or associates that
> structure to the function recited in the claim.' " *Med.*
> *Instrumentation & Diagnostics Corp. v. Elekta AB*, 344
> F.3d 1205, 1210 (Fed.Cir.2003) (quoting *B. Braun Med.*
> *Inc. v. Abbott Labs.*, 124 F.3d 1419, 1424
> (Fed.Cir.1997)).

Golight Inc. v. Wal-Mart Stores Inc., 355 F.3d 1327, 1333-34 (Fed. Cir. 2004).

The claimed second means corresponds to the viewer 40, which is described in the Specification as performing the claimed function. *See* Specification paragraphs [0020]-[0022]. *See also* Br. 8. Therefore, claim 23 requires the structure of the viewer 40 and equivalents thereof. To reject claim 23, the Examiner again relies upon the same rationale to reject claim 23. Final Rejection 9. For the same reasons as discussed above with regards to claim 1, we find that the Examiner has failed to establish a prima facie showing of obviousness in rejecting claim 23. The Appellants have overcome the rejection of claims 23 and claims 24-26, dependent thereon, under 35 U.S.C. § 103(a) over Stefik.

DECISION

The decision of the Examiner to reject claims 1-26 is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2010).

<u>REVERSED</u>

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